



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/129,308	08/05/1998	JAMES R. WHITLEDGE	98.442	4322

7590 03/29/2004

Blakely Sokoloff Taylor & Zafman, LLP  
12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1030

EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
----------	--------------

2176

23

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/129,308

Applicant(s)

WHITLEDGE ET AL.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is responsive to communications: RCE and amendment, filed 4/24/2002, to the original application filed 8/5/1998. IDS filed 10/13/1998 (paper #2), 3/4/2000 (paper #4), 4/13/2000 (paper #5), 5/23/2000 (paper #6), and 9/28/2000 (paper #7).
2. The rejection of claim 1 under 35 U.S.C. 112, second paragraph has been withdrawn as necessitated by amendment.
3. The rejection of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Madnick and Kurz has been withdrawn as necessitated by amendment.
4. The rejection of claims 1-7, 9-17, 20 under 35 U.S.C. 103(a) as being unpatentable over Spyglass Prism has been withdrawn as necessitated by amendment.
5. The rejection of claims 8, 18-19 under 35 U.S.C. 103(a) as being unpatentable over Spyglass and Madnick has been withdrawn as necessitated by amendment.
6. It is respectfully noted that two independent sets of rejections are applied to the instant claims.
7. Claims 1-20 are pending. Claim 1, 15, 20 are independent claims.

***Continued Examination Under 37 CFR 1.114***

8. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/27/2002 has been entered.

***Claim Objections***

9. **Claims 3, 16 are objected to** because of the following: Dependent claims 3 and 6 are objected to for being improper hybrid claims. The claims contain both method and computer readable medium as the subject matter, since in claims 4 and 6, "*A computer readable medium...*" claims a medium, as well as the method of the independent claims on which claims 3 and 16 depend, respectively. See Ex parte Lyell, 17 USPQ2d 1548. Appropriate correction is required.

***Examiner's Note***

10. The following rejections are based on a possible interpretation of dependent claims 3 and 16 as directed to method type claims.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1-6, 9-13, 15-17, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Spyglass Prism Concepts And Applications (hereinafter Spyglass Prism), 1997 Spyglass, Inc. pp. 1-7, with a public knowledge date of at least March 10, 1997, as evidenced by Newsflash: "Spyglass Prism Content Conversion Solution Debuted at Embedded Systems East '97", Spyglass Inc., retrieved 5/24/2000, pp. 1-3, <url:http://www.spyglass.com/newsflash/releases/97/031097prism.html>.**

**In regard to independent claim 1**, Spyglass Prism discloses network devices connected (via a first network) to a Spyglass Prism proxy server, which is in turn connected to the Internet (via a second network), for content conversion of fetched Web pages by said proxy server (Spyglass Prism p. 2, second paragraph from top, also Figure at middle of page; compare with claim 1 preamble *“In a first network with a plurality of network devices connected to a second network with a plurality of network devices, a method of content conversion for display on a first network device on the first network, comprising the following steps”*, and *“receiving a first hypertext document on a second network device on a first network, from a third network device on a second network”*).

Spyglass discloses conversion of a Web document via the use of a model utilizing a set of conversion rules specifically designed to convert said document within the limitations set forth by a user's portable network device (i.e. PDA) (Spyglass Prism p. 5 section Content Converter and Cache; compare with claim 1 *“creating a document object model from the first hypertext electronic document”*).

Spyglass discloses extraction of various hypertext tags for deletion or replacement (conversion) with other tags resulting in a new document suitable for display within said user's portable network device (Spyglass Prism pp. 5-6 section Content Converter and Cache). Spyglass Prism additionally discloses applying a set of conversion rules (a form of “content extraction expressions”) via a conversion script containing a set of rules/routines (a form of “content extraction conversion language”), as applied to a Web page for extracting and converting various specific hypertext elements (i.e. tags, along with associated content, such as images, etc.) in said Web page, thereby producing a new Web page (it is noted that displayed Web content, along with associated tags, comprise Web page content) (Spyglass Prism p.5, first and second paragraphs from top) (compare with claim 1 *“extracting one or more selected hypertext elements from the document object model using one or more content extraction expressions from a content extraction conversion language comprising a set of methods operable to identify at least one of the one or more hypertext elements in the hypertext electronic document”*, and *“converting one or more extracted hypertext elements using one or more content extraction operations from the content extraction conversion language”*, and *“creating a second hypertext electronic document on the second network device including one or more converted hypertext elements.”*).

**In regard to dependent claims 2-3, Spyglass Prism discloses:**

- sending a converted (second) Web page to a portable network device (Spyglass Prism p. 2 middle Figure; compare with claim 2).
- a computer readable medium (i.e. a hard drive with instructions) for implementing Spyglass Prism's proxy server is known in the computer art (compare with claim 3).

**In regard to dependent claims 4-6, Spyglass Prism discloses:**

- referencing elements via the use of conversion rules, said rules stored and manipulated by Device and User database tables (Spyglass Prism p. 6 section Administration and Logging (near bottom); compare with claim 4).
- utilizing said conversion rules and tag extraction as specifically applied to hypertext Web documents, which incorporate tags in hierarchical based layouts (Spyglass Prism p. 5 section Content Converter and Cache; compare with claims 5, 6).

**In regard to dependent claims 9-11, Spyglass Prism discloses a content converter, and a document (Internet) server. Spyglass Prism also discloses obtaining elements with hypertext tags (Spyglass Prism p. 2 middle figure, also p. 5 section Content Converter and Cache; compare with claims 9-11).**

The use of object oriented techniques for implementing the invention of Spyglass Prism is known in the computer software art.

**In regard to dependent claim 12, claim 12 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.**

Art Unit: 2176

**In regard to dependent claim 13**, Spyglass Prism discloses conversion of elements from an original document into a converted document (Spyglass Prism p.5 section Content Converter and Cache; compare with claim 13).

**In regard to independent claim 15**, claim 15 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

**In regard to dependent claim 16**, claim 16 incorporates substantially similar subject matter as claimed in claim 3, and is rejected along the same rationale.

**In regard to dependent claim 17**, Spyglass Prism discloses a portable network device, a content converter proxy, and a document server (Internet) (Spyglass Prism p. 2 middle figure; compare with claim 17).

**In regard to independent claim 20**, claim 20 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 1, and is rejected along the same rationale.

***Claim Rejections - 35 USC § 103***

13. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 7, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spyglass Prism as applied to claim 1, above.**

**In regard to dependent claim 7, Spyglass Prism does not specifically teach a template. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Spyglass Prism, because Spyglass Prism teaches user device customized conversion rules using a script as applied to an original Web page document, suggesting the use of a template to hold various said rules, etc., providing Spyglass Prism with the advantage of structure that templates provide (Spyglass Prism p. 5 section Content Converter and Cache, p.6 section Administration and Logging; compare with claim 7).**

**In regard to dependent claim 14, claim 14 incorporates substantially similar subject matter as claimed in claims 7 and 13, and is rejected along the same rationale.**

**15. Claims 8, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spyglass Prism as applied to claims 1, 15, above, and further in view of Madnick et al. (hereinafter Madnick), U.S. Patent No. 5,913,214 issued June 1999.**

**In regard to dependent claims 8, 18-19, Spyglass Prism does not specifically teach the use of prefixes "&%". However, Madnick teaches variables addressed as various symbols (Madnick column 12 Table 2 items 0&, A#; compare with claims 8, 18, 19). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Madnick to Spyglass Prism, providing Spyglass Prism an organized way to search or track various variables of interest via the use of "&" and "%".**

**16. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madnick et al. (hereinafter Madnick), U.S. Patent No. 5,913,214 issued June 1999, in view of Kurz, A., Data warehousing**



within intranet: prototype of a web-based executive information system, IEEE Database and Expert Systems Applications, September 1-2, 1997, pp.627-632.

In regard to independent claim 1, Madnick teaches:

- a first network incorporating a plurality of network devices (Madnick Figure 6 item 612) connected to a second network with a plurality of network devices (Madnick Figure 6 items 102, 300, 400, also column 4 lines 19-25; compare with claim 1 preamble *"In a first network with a plurality of network devices connected to a second network with a plurality of network devices, a method of content conversion"*).

- a Wrapper Generator on a single computer comprising a Data Retriever, fetches a web page from an Internet web site (Madnick Figure 6 items 614, 620, and 612", see also column 9 lines 48-52, 62-67; compare with claim 1 *"receiving a first hypertext electronic document on a second network device on a first network, from a third network device on a second network"*).

- a descriptor file customized for interaction and data extraction with a retrieved web page (Madnick column 10 lines 15-25, column 12 lines 5-11, table 2; compare with claim 1 *"creating a document object model from the first hypertext electronic document"*).

- a HTML descriptor file containing additional embedded tags, said tags providing extra information to the Wrapper Generator (Madnick column 15 lines 54-65; compare with claim 1 *"extracting one or more selected hypertext elements from the document object model..."*).

- using said additional embedded tags, along with the rest of the specification file, for web data extraction and conversion to a result data set (Madnick column 15 lines 60-67, column 16 lines 1-3; compare with claim 1 *"converting one or more extracted hypertext elements..."*).

- Madnick does not specifically teach creation of a second hypertext document including converted elements. However, Kurz teaches final HTML output display (Kurz p.629 Presentation layer, also p.631 Figure 4; compare with claim 1 *"creating a second...converted hypertext elements"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the final HTML page presentation to the

utilization of the embedded tags and web page data accessing of Madnick, because of Kurz's taught advantage of final web display, providing a familiar presentation of data to the returned data sets of Madnick.

- Madnick does not specifically disclose "content extraction conversion language". However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Madnick, because Madnick deals with various data extractions (using specialized wrapper generation routines incorporating specification files), from disparate network sources ( i.e. web pages, network databases, etc.) for returning result sets of information, therefore suggesting a content extraction language embodiment (incorporating a language for its implementation), and providing the advantage of information retrieval from different sources (Madnick column 2 lines 28-43; compare with claim 1 "*...content extraction conversion language*").

**In regard to dependent claim 2**, Madnick teaches returning data sets to a Data Receiver (Madnick Figure 6 items 102, 400; compare with claim 2).

**In regard to dependent claim 3**, Madnick teaches a CD-ROM embodying Madnick's invention (Madnick column 16 lines 17-21; compare with claim 3).

**In regard to dependent claim 4**, Madnick does not specifically teach saving references to a symbol table. However, Kurz utilizes parsing and identification of tokens, along with regular expressions using LEX and YACC, which strongly suggests a text compiler which uses symbol tables (Kurz p.163 item 3.1.1, p.164 Table 1; compare with claim 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Kurz to Madnick, because of Kurz's taught advantage of compiler strategy using symbol tables, providing parsing capabilities to Madnick..

**In regard to dependent claim 5**, Madnick teaches saving elements in a specification file (Madnick column 12 Table 2; compare with claim 5).

**In regard to dependent claim 6**, Madnick teaches data extraction from a plurality of web sources (Madnick column 13 lines 26-29; compare with claim 6).

**In regard to dependent claim 7**, Madnick teaches a specification file as a template (Madnick column 13 lines 34-36; compare with claim 7).

**In regard to dependent claim 8**, Madnick teaches variables addressed as various symbols (Madnick column 12 Table 2 items 0&, A#; compare with claim 8).

**In regard to dependent claims 9, 10**, Madnick teaches a Query Converter, Command Transmitter, and Data Retriever utilizing web document servers on the Internet (Madnick Figure 6 items 612, 612', 614; compare with claims 9, 10).

**In regard to dependent claim 11**, Madnick teaches a specification file declaring TYPE: WEB (Madnick column 12 Table 2, near top of table; compare with claim 11).

**In regard to dependent claim 12**, Madnick teaches CGI, a form of script (Madnick column 14 lines 28-32; compare with claim 12).

**In regard to dependent claims 13, 14**, Madnick teaches using additional embedded tags, along with the rest of a specification file, for web data extraction and conversion to a result data set (Madnick column 15 lines 60-67, column 16 lines 1-3). Madnick does not specifically teach creation of a second hypertext document including converted elements. However, Kurz teaches final HTML output display (Kurz p.629 Presentation layer, also p.631 Figure 4; compare with claims 13, 14). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the final HTML page presentation to the utilization of the embedded

tags and web page data accessing of Madnick, because of Kurz's taught advantage of final web display, providing a familiar presentation of data to the returned data sets of Madnick.

**In regard to independent claim 15,** claim 15 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

**In regard to dependent claim 16,** Madnick teaches a CD-ROM embodying Madnick's invention (Madnick column 16 lines 17-21; compare with claim 16).

**In regard to dependent claim 17,** Madnick teaches a Query Converter, Command Transmitter, and Data Retriever for fetching pages from a document server on the Internet (Madnick Figure 6 items 612, 612", 614; compare with claim 17).

**In regard to dependent claims 18, 19,** Madnick teaches variables addressed as various symbols (Madnick column 12 Table 2 items 0&, A#; compare with claims 18, 19).

**In regard to independent claim 20,** claim 20 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 1, and is rejected along the same rationale.

17. Applicant's arguments filed 9/27/2002 have been fully and carefully considered but they are not persuasive.

It is respectfully noted that Applicant's amendment eliminating "*data mining*" from the independent claims significantly changes the scope of the claimed invention when interpreted as a whole.

Regarding rejection set (Madnick and Kurz), Applicant argues on page 7 of the amendment that the combination of Madnick and Kurz would be rendered as having no utility and would be inoperable. It is respectfully noted that, although an embodiment of Kurz appears to gather information from highly structured sources, Madnick does not specifically limit its invention to extraction from Web pages, and can gather information from databases as well as semi-structured sources (see Madnick Abstract, at beginning and at middle, also Madnick Figure 6 items 300, 604, 606, 608, 610, 400, and 102). In addition, the examiner uses Kurz to specifically teach final HTML output display of Madnick's initial request from the Data Receiver (item 102), the final display is an HTML page containing converted elements (i.e. returned information). Since Madnick can retrieve data from databases and/or Web pages, its results can be displayed within Kurz's HTML results page.

Applicant argues on page 9 of the amendment that Spyglass does not teach and/or suggest "*data mining*". Although Applicant asserts (on page 6) that "*data mining*" can imply "*content extraction*", it is the examiner's opinion that they are not equal in scope. "*Data mining*" is a specific phrase of art directed to the "*mining*" or identification of commercially useful patterns or relationships from various sources, usually using statistical tools (i.e. stock prediction based upon periodic identification a set of stock quotes, or Census prediction, etc.). "*Content extraction*" on the other hand, is merely extracting content. Upon further consideration, the examiner notes that Spyglass discloses a set of conversion rules that define how Web content is to be translated. Spyglass also discloses specific "*Conversion Routines*" (methods), as well as an example "*image script*" (see Spyglass page 5). These disclosures can reasonable be interpreted as "*content extraction expressions*", and "*a content extraction conversion language*" (i.e. a script containing a set of routines of expressions – the script must be at least in a programming language, or text language form for processing).

Applicant argues on pages 10-11 of the amendment that Spyglass and Madnick are not combinable. It is respectfully noted that Spyglass extracts content for either conversion to another form, or elimination of said content if not supported by a specific target display device (i.e. PDA). Both references search and return content data accordingly. Regarding the Spyglass/Madnick combination, the examiner uses Madnick to specifically teach the use of prefixes "&%", and would benefit Spyglass by providing an organized way to search for content.

***Conclusion***

18. **Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

MICROSTRATEGY: DSS broadcaster – the industry's first information broadcast server, M2 Presswire, Dow Jones Interactive, pages 1-4, dated 3/20/1998.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on (703) 305-9792.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

20. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Application/Control Number: 09/129,308

Page 14

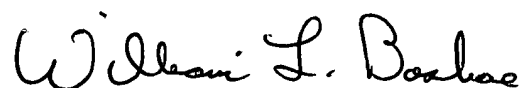
Art Unit: 2176

Washington, D.C. 20231

or faxed to:

(703-872-9306) (for formal/after-final communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Fourth Floor (Receptionist).**



William L. Bashore  
Patent Examiner, AU 2176  
March 21, 2004